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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,526	09/27/2001	Shinji Tomita	KPC-294	9267

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/963,526

Applicant(s)

TOMITA ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, 1st para. rej. against claims 1-2, 4-5, & 7.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' arguments filed 11/18/04 overcome the 35 USC 112, first paragraph rejections of record against claims 4-5 and 7 as set forth in paragraph 3(b) of the office action mailed 9/30/04. Further, applicants cancellation of claims 1-2 in the amendment filed 11/18/04 overcomes the 35 USC 112, first paragraph rejection against claims 1-2 as set forth in paragraph 3(a) of the office action mailed 9/30/04.

However, the amendment and arguments do not overcome (i) the 35 USC 112, first paragraph rejection of record with respect to claim 3 as set forth in paragraph 3(a) of the office action mailed 9/30/04 and (ii) the 35 USC 103 rejection of record utilizing Blum et al. (U.S. 6,706,801).

With respect to (i), applicants argue on page 4 of the amendment filed 11/18/04 that the 35 USC 112, first paragraph rejection is overcome with respect to claim 3 given that the claim was amended to delete the phrase "said resin fine particles are one of a solid and a powder".

However, it is noted that no such amendment to claim 3 has been made and thus, the rejection remains. It is noted that once the amendment is made, the 35 USC 112 rejection against the claim would be removed.

With respect to (ii), applicants argue that Blum et al. is not a relevant reference against the present claims given that while the present claims require that the ratio of isocyanate group in the (D) component, i.e. polyisocyanate, to 1 equivalent of hydroxyl group in the (A) component, i.e. acrylic resin, is greater than 2.0 equivalents and less than or equal to 4.0 equivalents, Blum et al. discloses using ratio of at least 0.5 but no more than 2.0 equivalents isocyanate to 1 equivalent of hydroxyl group which is outside the scope of the present claims.

However, it is the examiner's position that Blum et al. remains a relevant reference against the present claims for the following reasons.

Contrary to applicants' arguments, it is the examiner's position that the disclosure in col.13, lines 35-39 of Blum et al. does not limit the upper limit of the ratio to 2.0. While Blum et al. discloses that the preferred ratio of isocyanate to 1 equivalent of hydroxyl group is 0.8 to 2.0 and the particularly preferred ratio is 1 to 1.4, it is noted that "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of Blum et al. as a whole discloses broad ratio of isocyanate to 1 equivalent of hydroxyl group of "at least 0.5" which clearly encompasses the presently claimed ratio.


Further, even if the examiner agreed with applicants argument that the upper limit of the ratio of Blum et al. is 2 equivalents of isocyanate to 1 equivalent of hydroxyl group, it is the examiner's position that Blum et al. would remain a relevant reference against the present claims given that the recitation in the present claims that the ratio of isocyanate to 1 equivalent of hydroxyl group is "greater than 2.0 equivalents" encompasses values such as 2.01, 2.05, 2.1, etc. It is apparent, therefore, that the instantly claimed ratio of isocyanate to 1 equivalent of hydroxyl group and the ratio taught by Blum et al. are so close to each other that the fact pattern is similar to the one in *In re Woodruff*, 919 F.2d 1575, USPQ2d 1934 (Fed. Cir. 1990) or *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed.Cir. 1985) where despite a "slight" difference in the ranges the court held that such a difference did not "render the claims patentable" or, alternatively, that "a prima facie case of obviousness exists where the claimed

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ranges and prior art ranges do not overlap but are close enough so that one skilled in the art would have expected them to have the same properties”.

In light of the case law cited above and given that there is only a “slight” difference between the ratio disclosed by Blum et al. and the ratio disclosed in the present claims, it therefore would have been obvious to one of ordinary skill in the art that the ratio of isocyanate to 1 equivalent of hydroxyl group disclosed in the present claims is but an obvious variant of the ratio disclosed in Blum et al., and thereby one of ordinary skill in the art would have arrived at the claimed invention.

In light of the above, it is the examiner’s position that Blum et al. remains a relevant reference against the present claims.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
12/10/04